REMARKS

Claims 1-24 are pending in the application. Favorable re-consideration is requested.

At the outset, applicant notes with appreciation that the Examiner has withdrawn all of the previous rejections because of the applicant's positions that the previously cited prior art did not anticipate or render obvious the claimed invention. See the middle of page 8 of the Detailed Action, i.e., "Applicant's arguments filed 12/24/2008 have been fully considered and are persuasive." The Examiner has now cited new prior art rejections. As discussed below, these rejections should also be withdrawn.

In the middle of page 2 of the Detailed Action, in paragraph no. 2, the Examiner states that claims 1-27 are rejected under 35 U.S.C. 102(b) as being **anticipated** by Dadson in view of Givens. Applicant has already overcome this rejection based upon the Amendment and arguments of December 24, 2008. Thus, applicant believes that this stated rejection was erroneously copied from the last Office Action and is not really in this case at this time, and applicant also notes that there are only twenty-four claims pending in this application, not twenty-seven. Moreover, an "anticipation" rejection cannot be based upon a combination of two references. This is directly contrary to U.S. law which requires that an "anticipation" rejection be based on one piece of prior art. Finally, as further confirmation that this rejection was erroneously included in the pending Office Action, applicant notes that there are no stated reasons for the rejection. Thus, the rejection fails to state an anticipation position or a prima facie case of obviousness.

From the middle of page no. 3 through page no. 5 of the Detailed Action, Claims 1, 3, 5-6, 8-9, 12, 14, 15, 17-20 and 22-23 stand rejected under 35 U.S.C. 102(e) as allegedly being

anticipated by Bonsall (USP 5865766 -- referred to by the Examiner as B) in view of Pfeiffer (USP 502253 -- referred to as P by the Examiner). In response, applicant requests the withdrawal of this rejection because it is legally improper for an "anticipation" rejection to be based on multiple references. Moreover, if the Examiner intended to allege an obviousness rejection, such a rejection is also defective because there is no statement of a prima facie case of obviousness. Indeed, neither Bonsall nor Pfeiffer apply to the field of peritoneal dialysis – which is clearly the field of the claimed invention. Indeed, the claims are all directed to "**peritoneal dialysis**" in the preamble as well as the body of the claims. Bonsal and Pfeifer do not. Thus, one skilled in the art of peritoneal dialysis would not combine Bonsal and Pfeifer in any combination in order to arrive at the claimed peritoneal dialysis system that requires a specific peritoneal dialysis configuration. Applicant also notes that the rejection improperly refers to the Dadson reference at the bottom of page 4 of the Office Action, even though Dadson is not cited in this rejection. For at least the foregoing reasons, the rejection should be withdrawn, i.e., it is defective and does not present a prima facie case of obviousness or a proper anticipation rejection.

From the top of page no. 6 to the middle of page no. 7 of the Detailed Action, claims 2, 4, 13, 16 and 21 stand rejected under 35 U.S.C. 102(e) as allegedly being **anticipated** by B and P in view of Suzuki (USP 6595948 -- referred to as S by the Examiner). Again, applicant requests the withdrawal of this rejection because an "anticipation" rejection cannot be based on multiple references. In addition, at the bottom of page 6 and the top of page 7 of the Detailed Action, the rejection refers to the Dadson reference even though the rejection at the top of page 6 does not cite Dadson. As noted in the foregoing paragraph, neither Bonsall nor Pfeiffer apply to the field of peritoneal dialysis – which is the field of the invention. In fact, the claims are all directed to

"**peritoneal dialysis**" in the preamble as well as the body of the claims. Bonsal and Pfeifer do not. Thus, one skilled in the art of peritoneal dialysis would not combine Bonsal and Pfeifer as the primary references with Suzuki in any fashion in order to arrive at the claimed peritoneal dialysis system that requires a specific peritoneal dialysis configuration (Claim 2 = A peritoneal dialysis system comprising an automatic peritoneal dialysis sampling system according to claim 1, a supplying line and supplying means for supplying dialysis fluid to a peritoneal cavity, a draining line, draining means for draining the fluid from said peritoneal cavity, connecting means for allowing a connection to a Y-site on the draining line which is situated between the patient peritoneum and the draining means of the peritoneal dialysis system). For at least the foregoing reasons, the rejection should be withdrawn, i.e., it is defective and does not present a prima facie case of obviousness or a proper anticipation rejection.

From the middle of page no. 7 to the middle of page no. 8 of the Detailed Action, Claims 7, 10 and 11 stand rejected as allegedly being obvious over B and P in view of Klein (USP 4244787). In response, applicant requests the withdrawal of this rejection because it fails to state a prima facie case of obviousness. As noted in the foregoing paragraphs (which are applicable here because rejected claims 7, 10 and 11 include all of the features of claims 1 and 2), neither Bonsall nor Pfeiffer apply to the field of peritoneal dialysis – which is the field of the invention. Independent claim 1, dependent claim 2 and the rejected dependent claims 7, 10 and 11 are directed to a specific peritoneal dialysis system. Bonsal and Pfeifer do not. Thus, one skilled in the art of peritoneal dialysis would not combine Bonsal and Pfeifer as the primary references with Klein as the secondary reference in order to arrive at the claimed peritoneal dialysis system that requires a specific peritoneal dialysis configuration and components. The rejection does not explain how it would be reasonably apparent to combine the references and arrive at the claimed

invention. This confirms that the rejection does not comply with the Supreme Court's pronouncements in *KSR*. As stated by the Supreme Court in *KSR*, there must be a "reasonably apparent" way to combine references that would yield the claimed invention. In this case, the primary references do not even relate to peritoneal dialysis and, therefore, it would not be reasonably apparent to combine these primary references with the Klein reference in any fashion to arrive at the claimed invention, which requires, among other things:

> an automatic peritoneal dialysis sampling system adapted to automatically sample at specific time intervals volumic fractions of a dialysate contained in a peritoneum of a patient in order to evaluate peritoneal membrane characteristics and/or improve peritoneal dialysis for a given patient, wherein said peritoneal dialysis sampling system comprises a series of sampling containers, pumping means and a series of valves adapted to direct a certain quantity of each fluid sample to a specific sampling container,
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> a supplying line and supplying means for supplying dialysis fluid to a peritoneal cavity, a draining line, draining means for draining the fluid from said peritoneal cavity, connecting means for allowing a connection to a Y-site on the draining line which is situated between the patient peritoneum and the draining means of the peritoneal dialysis system, and
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> wherein said pumping means is of a peristaltic type.

For at least the foregoing reasons, the rejection should be withdrawn, i.e., it is defective and does not present a prima facie case of obviousness of dependent claims 7, 10 and 11.

Applicant respectfully submits that this application is in condition for allowance. A notice to that effect is earnestly solicited.

If the Examiner has any questions concerning this case, the undersigned may be contacted at 703-816-4009.

Respectfully submitted,

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